

this section relate to the "special technical features" of PCT Rule 13.2. Where the Markush practice is concerned, the explanations given in Section (f) have to be considered as a whole:

(f) "Markush Practice." The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

It is clearly set forth in this introductory paragraph, second sentence, that the requirement specified in PCT Rule 13.2 shall be considered to be met when the alternatives are of a similar nature. The determination whether or not the alternatives are of a similar nature is further explained in Section (f)(i):

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

- (A) all alternatives have a common property or activity, and
- (B) (1) a common structure is present, ie., a significant structural element is shared by all of the alternatives, or
- (B) (2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

Accordingly, the alternatives are of similar nature, and the requirement of PCT Rule 13.2 shall be considered to be met when either the conditions (A) and (B)(1) or the conditions (A) and (B)(2) are fulfilled. Sections (f)(i)(B)(1) and (B)(2) are further explained in the following:

- (ii) In paragraph (f)(i)(B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in

view of existing prior art.

The structural element may be a single component or a combination of individual components linked together.

- (iii) In paragraph (f)(i)(B)(2), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention.

In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

- (iv) The fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be a justification for a finding of a lack of unity of invention.
- (v) When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered by the examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised.

All of Applicants' compounds (I) share a significant structural element and belong to a recognized class of chemical compounds. The compounds therefore meet condition (B)(1) as well as condition (B)(2). Furthermore, all of the alternatives encompassed by Applicants' formula (I) have a common property or activity. Therefore, the alternatives covered by Applicants' formula (I) fulfil the conditions (A) and (B)(1) as well as the conditions (A) and (B)(2). Accordingly, the alternatives are of similar nature, and the requirement of PCT Rule 13.2 shall be considered to be met. It is therefore, again, respectfully requested that the Examiner reconsider the restriction requirement.

The Examiner has rejected Claims 1 to 11 under 35 U.S.C. §112, ¶2. Applicants appreciated and have fully adopted the Examiner's helpful suggestions regarding items i) and ii) (page 3 of the Office Action). In item iii) of the Office Action the Examiner contends that the language "a radical which can be hydrolyzed to COOH" is indefinite. It is respectfully submitted that the test of definiteness is whether one skilled in the art would understand the bounds of the

claim when read in the light of the specification (Morton Int. Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 28 USPQ2d 1190 (CAFC 1993); Orthokinetics Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ2d 1081 (CAFC 1986)). Hydrolysis is a reaction type well known and well defined in the art as eg. supported by the definition given in Webster's New Collegiate Dictionary (G.&C. Merriam Co. 1980, page 556 enclosed) or the explanations set out in Hawley's Condensed Chemical Dictionary (Van Nostrand Reinhold, 1987, page 614 enclosed). Accordingly, hydrolysis requires that a group of the compound is reacted with water to give -as is specified in Applicants' Claim 1- a COOH moiety. The fact that such reactions and the radicals that can undergo such hydrolysis reaction are well known to a person of ordinary skill is further supported by the attached copy of "Appendix B, Classification of Reactions" (Advanced Organic Chemistry, J. March, pages 1175 and 1176). The index "Appendix B" of this general textbook is organized by the resulting functional group and lists the reaction type and the starting group. Accordingly, hydrolysis reactions resulting in carboxylic acids can be carried out starting from eg. 1,1,1-trihalides, ortho-esters, acyl halides, anhydrides, esters, amides, oxazines, alkynyl halides primary nitro compounds and nitriles. In light of the above it is believed clear that a person of ordinary skill in the art to which Applicants' invention pertains is well aware of the metes and bounds of the language "a radical which can be hydrolyzed to COOH". Favorable reconsideration of the Examiner's position is respectfully solicited.

The Examiner has rejected Claims 1 to 11

- under 35 U.S.C. §102(a) as being anticipated by Raschack et al. (J. Cardiovasc. Pharmacol. 26(3), 397 (1995));
- under 35 U.S.C. §102(b) as being anticipated by Riechers et al. (J. Med. Chem. 32, 2123 (1996));
- under 35 U.S.C. §103(a) as being unpatentable over Baumann et al. (DE-A 43 13 412, published Oct. 27, 1994), and
- under 35 U.S.C. §103(a) as being unpatentable over Baumann et al. (DE-A 43 13 413, published Oct. 27, 1994).

Applicants have claimed October 14, 1994, as the earliest filing date (priority date). It is respectfully requested that the Examiner hold the above issues in abeyance to give Applicants an opportunity to complete their claim to priority, ie. submit the certified translation(s) of the priority document(s). The required documentation is

presently being mailed to Applicants' representative and will be submitted to the Examiner as soon as possible.

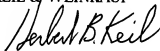
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. A check for the \$950.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Encls.: page 556 of *Webster's New Collegiate Dictionary* (G.&C. Merriam Co. 1980)
page 615 of *Hawley's Condensed Chemical Dictionary* (Van Nostrand Reinhold, 1987)
pages 1175-1176 of (*Advanced Organic Chemistry*, J. March, 1977).

HBK/BAS